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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/651,170 08/30/00 MONTGOMERY

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EXAMINER

HM12/0808

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ART UNIT

PAPER NUMBER

1614

DATE MAILED:

08/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/65170

Applicant(s)

MONTGOMERY et al

Examiner

S. H. ROSE

Group Art Unit

1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1874 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1874 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1874 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 34
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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There have been two IDS filings, November 22, 1900 and April 9, 2001. There are no copies (of record) of the documents supplied for the first one, and copies are requested. Also, please provide a short list of Robert Eric Montgomery applications and patents (U.S., WO/PCT etc.) Corresponding to claims 1, 3 to 10, for investigations of a double patenting issue.

This application, Serial No. 09/651170, was filed with fourteen claims on August 30, 2000, (with priority to Feb. 13 and 19, 1998), by Robert Eric Montgomery and Salin Nathoo.

Claims 1 to 14 are drawn to tooth whitening compositions comprising an oxidizing compound not necessarily a peroxide or per oxyacid as recited in claim 4, not necessarily a member of the (A) Markush group of peroxides, as recited in claim 5, or a member of the (B) Markush group of peroxide precursors as related in claim 6, and not necessarily containing a photo activating agent third component as recited in claims 2, 11 to 12, or the © Markush group of them as recited in claim 13, or the (D) species of titanium or zinc oxide semiconductor particles as recited in claim 14, said compositions also containing a (E) transparent carrier compound, not necessarily a (F) carboxypolymethylene gel, as recited in claim 3, and not necessarily an abrasive - free dental tooth whitening gel.

U.S. 6162055 (12/00) Montgomery et al, (IV) and (III), Bright smile WO/PCT 9940870A1 (8/99), (commonly assigned) are to a different applicant entity (both applicants and Anthony Cippola) and describe (A),(B),(C),(D),(E),(F), (overlapping in scope).

Montgomery (I-II) U.S. 5908614 (6/99) and 5922307 (7/99) describe and therefore anticipate: tooth whitening compositions comprising: a gel of carboxypolymethylene (claim 3),

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(an encompassed species of a transparent first component carrier); and an oxidizing compound one of a peroxide, peroxyacid, or peroxyacid precursor, as recited in claims 4 to 6, (as encompassed species of a tooth whitening facilitating transparent oxidizing second component) thereby anticipating claims 1, and 3 to 9, none of which recite or even require any third component photo activating agent, (required only by claims 2 and 10 to 14).

Encompassed species of photo activity components recited in claims 13 and 14 are described with encompasses species of oxidizing peroxides, peroxyacids, and/or peroxyacid precursors in the analogous stain removing bleaching art, as see:

Hermont et al (metal-ligand complex catalysts for activating oxidative bleaching and stain removal by hydrogen peroxide or by peroxy acids);

Heffner et al (I-II) (diketone activation of peroxygen bleaching and stain removed in dental cleaners with potassium monoperoxysulfate);

Speakman, (phthalocyanine-zinc metal complex as photo activator for sodium perborate stain removal, when irradiated with visible daylight);

Unilever (I) (benzotriazole in peroxy acid bleaching gel);

Murayama (I-II) describes titanium dioxide with hydrogen peroxide in a Carbopol carboxypolymethylene gel tooth whitening system, meeting claims 1 to 5, 7 to 14

Claims 1 to 14 directed to the same invention as that of claim 1 of commonly assigned 6162055. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

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Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Claims 1 to 14 directed to an invention not patentably distinct from claims 1 to 12 of commonly assigned 6162055. Specifically, they overlap in scope.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 to 14 rejected under 35 U.S.C. 103(a) as being obvious over US. 6162055.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 103(a) might be overcome either by a showing under 37

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CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application of any unclaimed subject matter prior to the effective U.S. filing date of the reference under 37 CFR 1.131. Details as noted above.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 to 14 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 12 of U.S. Patent No. 6162055. Although the conflicting claims are not identical, they are not patentably distinct from each other because of overlap in scope.

Claims 1 to 14 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5908614 or 5922307 in view of

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Hermont et al, Heffner et al (I-II), Speakman, Unilever (I) and Murayama (I-II) (details as noted above).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claims 1, 3 to 9 rejected under 35 U.S.C. 102(a) (b) (g) as being anticipated by Montgomery (I-II) (details as noted above).

Claims 1 to 14 rejected under 35 U.S.C. 102(a) (b) (g) as being anticipated by Murayama (I-II) (details as noted above).

Claims 1 to 14 rejected under 35 U.S.C. 102(e) as being anticipated by 6162055.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

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CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 to 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery (I-II-III-IV) (details as noted above) taken with anyone of each of Murayama (I-II), Unilever (I), Speakman, Heffner et al (I-II) or Hermont et al (details as noted above) in view of which it would

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be prima facie obvious to include an encompassed species of photo activator in a transparent carboxypolymethylene (Carbopol) gel of an encompassed species of oxidizing tooth bleach.

Claims 1 to 14 are generic to a plurality of disclosed patentably distinct species comprising

One ultimate disclosed species of:

(A) a photo activating component selected from one recited in claims 13 or 14

(B) one ultimate disclosed oxidizing compound from one of those recited in claims

5 or 6.

© (If further elected) one transparent carrier compound component recited in claim 3.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, of each even though this requirement is traversed. If this application is filed under Rule 371, the legal authority is PCT Rule 13.2, Annex B, Part 1 (f) "Markush Practice"; PCT Rule 13 and 35 U.S.C. § 372, rather than 35 U.S.C. § 121.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under U.S.C. § 103 (of) the other invention.

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Election of species is required per MPEP § 803, 809.02 (d) (Markush group claim practice, separate and burdensome fields of search required).

Patentably distinct Markush species are independent inventions, In re Webber, 198 USPQ 328, In re Haas, 198 USPQ 334. Divisional applications may be filed under 35 U.S.C. § 121, as a result of an Office requirement for an election of a patentably distinct species as made herein. In re Joyce, 115 USPQ 412, In re Herrick, 115 USPQ 412. This satisfies the “patentably distinct” criterion since the Examiner is not of the opinion that the various species are obviously unpatentable over one another, and each species (as noted above) is capable of independent manufacture, use and sale, with the other components of the claimed formulations.


Applicant is further required to identify the claims that correspond to the elections as well as those that do not even if the requirements are traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday-Thursday from 7:30 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Shep Rose
Senior Primary Examiner
Art Unit 1614

SKR: mv
August 1, 2001

**SHEP K. ROSE
PRIMARY EXAMINER
GROUP 1200**